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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,584	10/31/2003	Patrick J. Treado	E2079-00013	1644

41396 7590 09/06/2005

DUANE MORRIS LLP  
IP DEPARTMENT  
30 SOUTH 17TH STREET  
PHILADELPHIA, PA 19103-4196

EXAMINER
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PRITCHETT, JOSHUA L

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

10/698,584

Applicant(s)

TREADO ET AL.

Examiner

Joshua L. Pritchett

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) 12, 13 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/04, 1/04</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This action is in response to Amendment filed July 14, 2005. In response to a restriction requirement the applicant cancelled claims 17-40 relating to one of the groups of claims in the restriction requirement. The examiner will examine claims 1-16.

#### ***Information Disclosure Statement***

The information disclosure statement filed July 28, 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The reference, ChemImage advertising brochure, was not included in the filing of the information disclosure statement.

#### ***Claim Objections***

Claims 12, 13 and 15 are objected to because of the following informalities: the claims appear to have been copied from an optical character recognition program and include the word, "nom" which the examiner believes should instead be the term, "from." Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 9, 10 and 12-16 rejected under 35 U.S.C. 102(b) as being anticipated by Batchelder (US 5,689,333).

Regarding claim 1, Batchelder discloses an apparatus comprising a light source (10) for illuminating a specimen (4; Fig. 1); light gathering optics for gather light reflected from the specimen (Fig. 1); an electronically tunable filter (84) for transmitting light of specific, selected wavelengths (Fig. 1; col. 4 lines 49-55); an image sensor (12) for sensing an image, the image sensor having a predetermined number of pixels (col. 8 lines 5-6); a computer (120), the computer being coupled to the electronically tunable filter and the image sensor (col. 4 lines 49-55; Fig. 1) software running on the computer (col. 10 line 53) tuning the electronically tunable filter to a specific wavelength or a series of specific wavelengths (col. 4 lines 49-55) and collecting and storing the intensity of the reflected light at each of the pixels for each of the specific wavelengths to which the electronically tunable filter is tuned (col. 10 lines 52-65; Figs. 4-6).

Regarding claim 2, Batchelder discloses the light source is incident to the specimen (Fig. 1).

Regarding claim 3, Batchelder discloses the light source emits a specific wavelength or range of wavelengths (col. 3 lines 50-67).

Regarding claim 4, Batchelder discloses the light gathering optics comprise a microscope lens (20).

Regarding claim 5, Batchelder discloses the light gathering optics comprise a macro lens (34).

Regarding claim 9, Batchelder discloses the image sensor is a two-dimensional imaging focal plane array (Fig. 8; col. 9 lines 20-22).

Regarding claim 10, Batchelder discloses the image sensor is a charge coupled device (Fig. 1).

Regarding claim 12, Batchelder discloses one or more mirrors for spatially directing the light reflected by the specimen (Fig. 1).

Regarding claim 13, Batchelder discloses an optical train disposed between the light gathering optical and the electronically tunable filter for matching the spatial characteristics of the light reflected by the specimen to the tunable filter (Fig. 1).

Regarding claim 14, Batchelder discloses a display device for rendering images and graphical representations of the specimen (Figs. 4-6).

Regarding claim 15, Batchelder discloses the software performs the function of composing an image for rendering on the display, the image composed of light reflected by the

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specimen at a specific wavelength or range of wavelengths to which the tunable filter has been tuned (col. 8 lines 58-60).

Regarding claim 16, Batchelder discloses the software performs the function of composing a graphical representation of the specimen, being a graph of intensity versus wavelength for specific pixels or groups of pixels (Figs. 4-6; col. 10 lines 50-65).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Batchelder (US 5,689,333) in view of Treado (US 6,002,476).

Batchelder teaches the invention as claimed including the use of tunable filter bandwidth ranges from 5 cm<sup>-1</sup> to 10 nm (Fig. 4). Batchelder lacks reference to liquid crystal tunable filters or acousto-optic tunable filters. Treado teaches the use of liquid crystal tunable filters (LCTF; 11 Fig. 1) and acousto-optic tunable filters (col. 1 lines 48-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Batchelder tunable filter include either a liquid crystal tunable filter or an acousto-optic tunable filter for the purpose

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of accurately and precisely filtering desired bandwidths with known technology to yield predictable results.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Batchelder (US 5,689,333) in view of Fillard (US 5,770,856).

Batchelder teaches the invention as claimed but lacks reference to a gallium arsenide detector. Fillard teaches the use of a gallium arsenide detector to collect light (col. 2 lines 55-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Batchelder invention include the gallium arsenide detector of Fillard for the purpose of accurately and precisely collecting light with known technology to yield predictable results.

### *Conclusion*

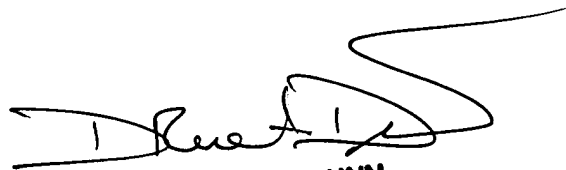
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP



**DREW A. DUNN**  
**SUPERVISORY PATENT EXAMINER**